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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,457	11/20/2001	J. David Cabello	004-US-003	3815

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EXAMINER

MARTIN, CIARA A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,457

Applicant(s)

CABELLO, J. DAVID

Examiner

Ciara Martin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/20/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s), _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 9 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the application filed on November 20, 2001. Claims 1-26 are pending. Claims 1-26 represent a blind postscript function and electronic mail.

Specification

2. The abstract of the disclosure is objected to because the article "a" is used in improper English language grammar directly preceding the word "electronic." "A" should be replaced with "An" before the word "electronic" in the 4th line. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 9 is objected to because it should read "wherein the act of identifying..." on the first line. It currently reads "wherein a act of identifying..."
4. Claim 23 is dependent on claim 12 not on the immediately preceding independent claim 22. Claim 23 should be dependent on claim 22.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohler, U.S. Patent No. 6,192,396.

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7. Kohler teaches the invention as claimed including a computerized messaging system which authors messages that contain recipient-specific content, so that each recipient does not necessarily receive a message that is identical to all other recipients (see abstract).

8. As per claims 1, 12 and 22, Kohler teaches:

a program storage device, readable by a programmable control device, comprising instructions stored on the program storage device for the programmable control device (see column 4 lines 31 to column 5 line 9 & column 1, lines 21-33, 47-51; Kohler discloses a computer system consisting of a storage device, control devices, and computer-executable processes in the storage device for the control device);

an electronic mail system, comprising: a display unit; and a computer unit operatively coupled to the display unit, the computer unit including a processor, a network means and a storage device, the storage device having stored thereon instructions for causing the processor to provide an electronic mail capability to a user through the display and the network means (see column 4 lines 31 to column 5 line 9 & column 1, lines 21-33, 47-51; Kohler discloses a computer system consisting of a display, a CPU (central processing unit), a network interface to provide computer access to computerized messaging system, a storage device, and computer-executable processes in order to send a message);

as well as an electronic mail method, comprising:

generating a first message (see column 1, lines 22-34; Kohler discloses sending a text message, sending a message implies generating a message);

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identifying a primary recipient of the first message (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the TO: and CC: category, sending a message to recipients involves having first identified the recipients and those recipients in the TO: and CC: category are primary recipients);

identifying a secondary recipient of the first message (see column 1, lines 22-44; Kohler discloses sending a message to recipients in the BCC: category, sending a message to recipients involves having first identified the recipients and those recipients in the BCC: category are secondary recipients);

associating a second message with the identified secondary recipient (see column 1, lines 21-44; Kohler discloses sending a message only the BCC: recipients, the BCC: recipients are the secondary recipients); and

sending only the first message to the primary recipient and the first and second messages to the secondary recipient (see column 1 lines 35 – column 2 line 4; Kohler discloses sending a message to a plurality of recipients with recipient-specific content, such that primary recipients receive a message and secondary recipients receive the same message as well as another message intended only for them).

9. As per claims 2, 13 and 23 Kohler teaches the act of sending further comprises:

withholding the identity of the secondary recipient from the primary recipient (see column 1, lines 22-34; Kohler discloses the recipients of to: and cc: recipient categories [primary recipients] are not aware of the message also being sent to the bcc: recipient category [secondary recipients]).

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10. As per claim 3, Kohler teaches the act of identifying a primary recipient comprises:

designating one or more recipients in an electronic mail message TO: field (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the TO: category; these are directly-intended, primary recipients; sending a message to recipients involves having first identified the recipients.)

As per claim 4, Kohler teaches the act of identifying a primary recipient further comprises:

designating one or more recipients in the electronic mail message CC field (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the CC: category; these are courtesy-copy, primary recipients; sending a message to recipients involves having first identified the recipients).

11. As per claim 14, Kohler teaches the instructions to identify a primary recipient comprise instructions to allow a user to: designate one or more recipients in an electronic mail message TO field (see column 1, lines 22-34; Kohler discloses sending an electronic mail message to recipients in the TO: category; sending a message to recipients involves designating those recipients);

and designate one or more recipients in the electronic mail message CC field (see column 1, lines 22-34; Kohler discloses sending an electronic message to recipients in the CC: category; sending a message to recipients involves designating those recipients).

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12. As per claims 5 and 15, Kohler teaches the act of identifying a secondary recipient comprises:

designating one or more recipients in an electronic mail message BCC field (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the BCC: category; these are blind-courtesy-copy, secondary recipients; sending a message to recipients involves having first identified the recipients).

13. As per claims 6 and 16, Kohler the act of identifying a primary recipient comprises:

identifying a plurality of primary recipients (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the TO: and CC: category, sending a message to recipients involves having first identified the recipients and those recipients in the TO: and CC: category are primary recipients);

wherein each of said plurality of primary recipients are designated to receive only the first message (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the TO: and CC: category, sending a message to recipients involves having first identified the recipients and those recipients in the TO: and CC: category are primary recipients); and

the act of sending comprises:

withholding the identity of the secondary recipient from each of the plurality of primary recipients (see column 1, lines 22-34; Kohler discloses the recipients of to: and cc: recipient categories [primary recipients] are not aware of the message also being sent to the bcc: recipient category [secondary recipients]).

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14. As per claims 7 and 17, Kohler teaches the act of identifying a secondary recipient comprises:

identifying a plurality of secondary recipients (see column 1, lines 22-34; Kohler discloses sending a message to recipients in the BCC: category; these are blind-courtesy-copy, secondary recipients; sending a message to recipients involves having first identifying the recipients).,

wherein each of said plurality of secondary recipients are designated to receive the first message and the second message (see column 1 lines 35 – column 2 line 4; Kohler discloses sending a message to a plurality of recipients with recipient-specific content, such that secondary recipients receive a message as well as a second message); and

the act of sending comprises withholding the identity of each of the plurality of secondary recipients from the primary recipient (see column 1, lines 22-34; Kohler discloses the recipients of to: and cc: recipient categories [primary recipients] are not aware of the message also being sent to the bcc: recipient category [secondary recipients]).

15. As per claim 8, Kohler teaches withholding, from each of said plurality of secondary recipients, the identity of the other plurality of secondary recipients (see column 1 lines 21-33; Kohler discloses BCC: recipients receive messages without other recipients being aware of such, including other BCC: recipients).

As per claim 18, it is a product claim of claim 8 and does not teach or define any new limitation above claim 8 and therefore is rejected for similar reasons.

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16. As per claims 9, 19 and 24, Kohler teaches the act of identifying a secondary recipient comprises:

identifying a first secondary recipient and a second secondary recipient (see column 1, lines 22-34; Kohler discloses sending a message to more than one recipient in the BCC: category; these are blind-courtesy-copy, secondary recipients; sending a message to recipients involves having first identified the recipients).

17. As per claims 10, 20 and 25 Kohler teaches the act of associating a second message with the identified secondary recipient comprises:

associating a first second message with the first secondary recipient (see column 1 line 21 to column 2 line 26; Kohler discloses sending selected portions of a message to BCC: recipients, so that one message goes to some secondary recipients); and

a second second message with the second secondary recipient (see column 1 line 21 to column 2 line 26; Kohler discloses sending selected portions of a message to BCC: recipients, so that another portion of the message goes to another set of secondary recipients);

wherein the first second message and the second second message are different (see column 1 line 21 to column 2 line 26; Kohler discloses selected portions are sent to certain recipients. Each portion being a different message. Thus, one portion is designated to certain recipients and another portion to other recipients. The BCC: recipients can be selected to receive different messages, sending a message to recipients involves having first identified the recipients).

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18. As per claims 11, 21 and 26 Kohler teaches the act of associating a second message comprises:

associating a file selected from the group consisting of a text file, an application document file, an image file and an executable file (see column 1 line 52 to column 2 line 4; Kohler discloses the email can be a message or an attachment, emails are messages, and attachments can consist of a text file, an application document file, an image file or an executable file).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clissold et al. U.S Patent Application Publication No. 2003/0061289, Watanabe U.S. Patent No. 6,327,612 and Non-Patent Literature: "Sending an Email to Multiple Recipients - Cc: and Bcc:" by Heinz Tschabitscher published on October 10, 1999 in <http://email.about.com>.

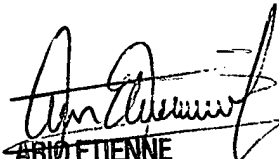
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ciara Martin whose telephone number is 571-272-7507. The examiner can normally be reached on M-F 6:30- 4:00 with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1/12/05


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